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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,326	11/23/2001	Anthony Derose	PT-1475000	2546
23607	7590	12/16/2004	EXAMINER	
IVOR M. HUGHES, BARRISTER & SOLICITOR, PATENT & TRADEMARK AGENTS 175 COMMERCE VALLEY DRIVE WEST SUITE 200 THORNHILL, ON L3T 7P6 CANADA			SILBERMANN, JOANNE	
		ART UNIT		PAPER NUMBER
		3611		
DATE MAILED: 12/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/990,326	DEROSE, ANTHONY	
	Examiner Joanne Silbermann	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9, 12-16, 21-29 and 31-43 is/are pending in the application.  
 4a) Of the above claim(s) 29 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9, 12-16, 21-28, 31-43 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Claim 29 stands withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-9, 12-16, 21-26 and 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claim 1, lines 3 and 4 said grooves and characteristics lack antecedent basis, and in line 5 it is not clear if these are the same grooves, ridges or characteristics as previously recited or additional ones.
4. In claim 4 “the ornament/design or sign” lacks proper antecedent basis. Only an ornament is recited in claim 1.

Claims 6 and 9 contain the trademark/trade name LEXAN. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify

a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe the solid material and, accordingly, the identification/description is indefinite.

In claim 8 lines 7-8 "the translucent surfaces, grooves and, ridges or characteristics" lacks proper antecedent basis, since only one of each is recited in line 3. In claim 12 lines 7-8 "the light scattering means" lacks antecedent basis.

In claim 14, it is not clear why "secondary light scattering elements" are recited again.

In claim 21 line 9 "said light scattering surface" is not definite, since several of these surfaces have been recited (in line 8). Also, in lines 10-11, it is not clear if yet an additional surface is being claimed, or if this is one already recited in line 8.

In claim 23 "said pairs of wires" lacks antecedent basis, since only one pair is recited.

In claims 39 and 43 "The design/sign/ornament" lacks antecedent basis.

The remaining claims are rejected as depending from rejected base claims.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

- A person shall be entitled to a patent unless –
  - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-7, 12, 13, 15, 21, 22, 27, 31, 34-36, 39 (as dependent from 1, 12, 21, 27, 34 and 35) and 42, as far as definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Giuliano et al.

7. Giuliano et al. teach an ornament comprising a body panel 10 made of plastic having sides and an etched surface 10a with a design 12 (Figures 1 and 2). This design may be any non-random image (column 2 line 22) which includes designs of company logos. Opening 11 in one side of the body holds light emitting diode 1 by means of transparent material 2. A plurality of light sources may be used. The body panel may be colored and may include a mirrored surface. Giuliano et al. also disclose a switching/timer device for operating the display.

8. The display of Giuliano et al. is decorative, in that it is described as "design art" (column 1 line 45) and "an art rendering" (column 2 line 21). The artwork or rendering is considered to be a symbol, as recited in claim 13 and may be for Christmas, as recited in claim 21.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 3, 37, 38 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Ming-ho.

11. Giuliano et al. do not specifically teach a Christmas ornament, Santa Claus, crucifix or heart, however, Ming-ho teaches a variety of ornaments and structures, as discussed in column 14 lines 37-53. It would have been obvious to a person having ordinary skill in the art to utilize any well known shape or ornament to serve the user's particular purpose. Additionally, matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. *In re SEID*, 73 USPQ 431 (CCPA 1947).

12. Claims 8 (and 39 as dependent therefrom) and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Lee, '983.

13. Giuliano et al. do not teach supporting rails in a housing, however, Lee teaches a housing 1 with one rail structure at the top of the sign. Lee further teaches light emitting diodes located in the rail structure. It would have been obvious to a person having ordinary skill in the art to utilize such a rail structure to support the ornament of Giuliano et al. It would have been obvious to one of ordinary skill to provide another similar rail structure at the bottom of the sign and separated to receive the display, as this would be a duplication of known parts.

14. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Dimmick.

15. Giuliano et al. do not teach the secondary light scattering elements as being shavings or bubbles, however this is well known in the art. Dimmick teaches an illuminated sign including light scattering means comprising bubbles (column 4 lines 67-68). It would have been obvious to a person having ordinary skill in the art to utilize

bubbles as a light scattering means (as shown by Dimmick) to provide additional, increased illumination for the display.

16. Claims 16, 23-26, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giulinao et al. in view of Voland.

17. Giuliano et al. do not teach a string of ornaments, however Voland teaches string 14 of ornaments 15. The ornaments are different sizes and shapes. It would have been obvious to one of ordinary skill in the art to utilize a string of ornaments to provide a larger, more aesthetically pleasing display.

18. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Day et al.

19. Giuliano et al. do not teach using the illumination in a necklace, however this is well known in the art as shown by Day et al. It would have been obvious to one of ordinary skill to utilize the illumination of Giuliano et al. et al. in forming a necklace so as to provide an illuminated pendant, as is discussed by Day et al.

20. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. in view of Oda et al.

21. Giuliano et al. do not teach a reflective panel, however such panels are well known in the art of signs. Oda et al. teach a sign having illumination and concave reflector 5. It would have been obvious to one of ordinary skill to utilize such a reflector so as to provide more illumination from the light sources, as is the purpose of reflectors.

***Response to Arguments***

22. Applicant's arguments filed November 12, 2004 have been fully considered but they are not persuasive.

23. Applicant argues that Giuliano et al. do not show an ornament. According to Applicant's dictionary definitions, an ornament may be anything that decorates or adorns, or an object designed to add beauty. All of these definitions are met by artwork, which is what Giuliano et al. describe.

24. Regarding the Ming-ho reference, Applicant argues that the device of Giuliano et al. may not be combined with that of Ming-ho. The Ming-ho reference has been applied to teach illuminated, decorative ornaments in a variety of shapes and sizes as being well known in the art. At no point in the rejection did the examiner state that Ming-ho taught display of Santa Claus, a crucifix, or a heart, as is alleged in Applicant's remarks, page 14 fourth paragraph.

25. Regarding the Voland reference, Applicant argues that Voland does not teach a string of ornaments. Voland, however, teaches in Figure 6 ornaments that may replace the spheres (see also column 4 lines 20-24).

26. Regarding Applicant's sample, the examiner plugged it in but it did not light up. The examiner does however appreciate receiving the sample.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 703-308-2091. The examiner can normally be reached on M-F 5:30 - 2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Joanne Silbermann*  
Joanne Silbermann  
Primary Examiner  
Art Unit 3611

JS